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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/265,710	03/09/99	BANDMAN	0 PF-0339-1DIV

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HM22/0330

EXAMINER

ULM, J

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

03/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/265,710

Applicant(s)
Bandman et al.

Examiner
John Ulm

Group Art Unit
1646



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, and 12-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1, 2, and 12-18 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

Claims 1, 2 and 12 to 18 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 12, drawn to an isolated human integral membrane protein, classified in class 530, subclass 350.
- II. Claim 13, drawn to an antibody, classified in class 530, subclass 388.22.
- III. Claim 14, drawn to a compound of unspecified constitution which is a receptor agonist, class undeterminable, subclass undeterminable.
- IV. Claim 15, drawn to a compound of unspecified constitution which is a receptor antagonist, class undeterminable, subclass undeterminable.
- V. Claim 16, drawn to a method of treating cancer by administering a human integral membrane protein, classified in class 514, subclass 2
- VI. Claims 17 and 18, drawn to a method of treatment by administering a compound of unspecified constitution which is a receptor antagonist classified in class undeterminable, subclass undeterminable.

The inventions are distinct, each from the other because:

The protein that is invention I, the antibody that is invention II, the agonist of unspecified constitution that is invention III and the antagonist of unspecified constitution that is invention IV are five structurally and functionally different chemical compounds each of which can be made and used without any one or more of the other compounds. Lack of unity is shown because these

Art Unit: 1646

compounds lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

Inventions I and IV are each related to inventions V and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product that is invention IV could be used to detect the presence of the protein of invention I in a sample and the protein that is invention I could be used to detect the presence of the product of invention IV in a sample, each of which is a process that is materially different from a method of treatment.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 1646

amendment of inventorship must be accompanied by a diligently-filed petition under 37


CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kuntz can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800